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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/839,844	04/20/2001	Nir Kossovsky	M-7529-4C US	2669

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EXAMINER	
CHENCINSKI, SIEGFRIED E	

ART UNIT	PAPER NUMBER
3628	

DATE MAILED: 09/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/839,844	KOSSOVSKY ET AL.	
	Examiner	Art Unit	
	Siegfried E. Chencinski	3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *20 April 2001*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *4-6 and 11-26* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *4-6 and 11-26* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *4/20/2001,6/8/2001*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Priority

The earliest effective filing date of the instant application is May 26, 2000 since only the parent application 09/580,005 supports the subject matter claimed in the instant application.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 4, 6, 11, 13, 14, 16, 17, 18 & 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eder (US Patent 6,321,205 B1) in view of Donner (US Patent 5,999,907) and Schumacher et al. (US Patent 6,349,275 B1, hereafter Schumacher).

Re. Claims 4, 11, 14, 17, 18 & 22, Eder discloses a computer system, method and storage medium for storing information about intellectual property assets, the computer system comprising:

- at least one server computer connected to one or more client computers via a global a computer program executed by the server computer (Col. 5, ll. 16-30);
- wherein the computer program further comprises computer instructions for:
    - storing user defined units and the quantitative information (Col. 5, l. 28).

Eder does not explicitly disclose translating quantitative information about attributes of a technology described by the intellectual property assets from user defined units to standard scientific units. However, Donner discloses computer automated systems for translating information (Col. 6, ll. 40-42). Further, Schumacher discloses a specific system for translating business and scientific information across languages and units of measure (Col. 1, ll. 15-21, 57-59; Col. 8, l. 56 – Col. 9, l. 24). An automated system for

translating user defined units to scientific units would have been obvious to the ordinary practitioner of the art. It would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to have combined the disclosures of Eder with those of Donner and Schumacher for obtaining and storing information about technology described by the intellectual property assets by a computer automated means for the purpose of efficiently and quickly valuing and auditing intellectual property assets for commercial purposes, such as potential trading of such assets and financial valuations of businesses owning such assets (Donner, Col. 2, ll. 45-61).

Re. Claims 6, 13 & 16, neither Eder nor Schumacher explicitly disclose a computer system, method and storage medium wherein the computer program further comprises instructions for translating quantitative information in standard scientific units to user defined units for display to the user. However, as stated above in the rejection of claim 4, Donner discloses computer automated systems for translating information revealed in US Patent 4,814,988 (Col. 6, ll. 40-42). An automated system for translating user defined units to scientific units would have been obvious to the ordinary practitioner of the art. It would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to have combined the disclosures of Eder and Schumacher with those of Donner for obtaining and storing information about technology described by the intellectual property assets by a computer automated means for the purpose of efficiently and quickly valuing and auditing intellectual property assets for commercial purposes, such as potential trading of such assets and financial valuations of businesses owning such assets (Donner, Col. 2, ll. 45-61).

3. **Claims 5, 12, 15, 19 & 23 are rejected** under 35 U.S.C. 103(a) as being unpatentable over Eder in view of Donner and Schumacher as applied to claims **4, 11, 14, 17, 18 & 22** above, and further in view of Martin (US Patent 6,330,547 B1) and Barron's Dictionary of Accounting Terms.

Claims 5, 12 & 15 & 23, Eder discloses a computer system, method and storage medium wherein the quantitative information for each attribute comprises a description of the attribute and a value of the attribute. Eder includes a methodology for valuing

intangible assets, which defines Intellectual Property. An ordinary practitioner of the art would have considered Eder's teaching a prudent methodology for establishing a maximum value of the commercially useful characteristics of a technology or intellectual property in comparison to the establishment of a minimum commercial value of an intellectual property. Eder, Donner and Schumacher do not explicitly disclose techniques for estimating a minimum value of the attribute achieved by a technology by teaching a minimum valuation techniques for in this minimum valuation technique is the establishment of liquidation value. However, Martin discloses techniques for estimating a minimum value of the attribute achieved by a technology by teaching a minimum valuation techniques through the establishment of a liquidation value. Barron's Dictionary of Accounting Terms defines liquidation value as "cash price or other consideration that can be received in a forced sale of assets, ... less than what could be received from selling assets in the ordinary course of business". (Abstract, ll. 2, 13; Col. 1, l. 67; Col. 2, ll. 10-15;). It would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to have combined the disclosures of Eder with those of Martin and Barron's Dictionary of Accounting Terms in order to provide broader access to traditional lending sources for companies wanting to make use of emerging technologies based on intellectual property (Martin, Col. 2, ll. 3-5).

Re. Claim 19, Eder discloses a computer system, method and storage medium wherein the quantitative information for each attribute comprises a description of the attribute and a value of the attribute. Eder includes a methodology for valuing intangible assets, which defines Intellectual Property. Eder's teaching can be considered a methodology for establishing a maximum value of the attribute achieved by a technology. Schumacher discloses the use of standard scientific units. Eder, Donner and Schumacher do not explicitly disclose a technique for estimating a minimum value of an attribute achieved by a technology by teaching a minimum valuation technique. However, Martin discloses techniques for estimating a minimum value of the attribute achieved by a technology by teaching a minimum valuation techniques for in this minimum valuation technique is the establishment of liquidation value. Barron's Dictionary of Accounting Terms defines liquidation value as "cash price or other

consideration that can be received in a forced sale of assets, ... less than what could be received from selling assets in the ordinary course of business". (Abstract, ll. 2, 13; Col. 1, l. 67; Col. 2, ll. 10-15;). Lastly, the use of standard scientific units of measure would have been obvious to the ordinary practitioner of the art. It would consequently have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to have combined the disclosures of Eder, Donner and Schumacher with those of Martin, Barron's Dictionary of Accounting Terms and the use of standard scientific units of measure in order to provide broader access to traditional lending sources for companies wanting to make use of emerging technologies based on intellectual property (Martin, Col. 2, ll. 3-5).

4. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Eder. **Re. Claim 20,** Eder discloses a method for storing information about intellectual property assets using a computer system comprising at least one server computer and one or more client computers connected to the server computer via a global-area network, the method comprising:

storing quantitative information about attributes of a technology described by the intellectual property assets (Col. 5, ll. 16-30). The specific details of what is stored and what is transmitted across any electronic network is within the inherent capability of the electronic storage device and the electronic communications systems. Consequently, an ordinary practitioner of the art at the time of Applicant's invention would have found it obvious to combine the disclosures of Eder with the inherent capabilities of computer systems and electronic networks to establish a networked computer system for intellectual property information storage and evaluation motivated by a desire to provide financial evaluations of the impact of intellectual property on a business (Eder, Col. 4, ll. 59-67).

5. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Eder as applied to claim 20 above, and further in view of Schumacher.

Re. Claim 21, Eder does not explicitly disclose a method wherein the quantitative information for each attribute comprises a standard scientific unit, a description of the attribute, a minimum value of the attribute achieved by the technology, expressed in the unit, and a maximum value of the attribute achieved by the technology, expressed in the unit. However, Schumacher discloses a specific system for translating business and scientific information across languages and units of measure (Col. 1, ll. 15-21, 57-59; Col. 8, l. 56 – Col. 9, l. 24). This system includes every kind of information used in business and scientific communications. It would have been obvious to an ordinary practitioner of the art that this includes quantitative information for each attribute comprises a standard scientific unit, a description of the attribute, a minimum value of the attribute achieved by the technology, expressed in the unit, and a maximum value of the attribute achieved by the technology, expressed in the unit. It would consequently have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to have combined the disclosures of Eder with the disclosure of Schumacher in order to provide business and financial models for the application of emerging technologies based on intellectual property so that their implementation can be financed or financially traded (Eder, Col. 4, ll. 59-67).

6. **Claims 24, 25 & 26 are rejected** under 35 U.S.C. 103(a) as being unpatentable over Donner in view of Eder.

Re. Claims 24, 25 & 26, Donner discloses a computer system method and storage system for storing and retrieving information about intellectual property assets, the computer system comprising:

- a computer program executed by the server computer (Col. 3, l. 39. Col. Col. 7, ll. 60-61. The server is inherent.);

wherein the computer program further comprises computer instructions for:

- receiving a description of an intellectual property asset including descriptive quantitative information in descriptive user defined units (Col. 3, ll. 50-51);

- translating the descriptive quantitative information in the descriptive user defined units into standard scientific units (Col. 6, ll. 32-45).
- storing the description including the descriptive quantitative information in standard scientific units (Col. 3, l. 42);
- receiving a query including query quantitative information in query user defined units (the basic query to have the intellectual property valued - Col. 3, ll. 7-10; The computer query steps – Col. 3, ll. 38-55);
- translating the query quantitative information in the query user defined units into standard scientific units (Col. 6, ll. 32-45. A variety of translation software are available for different translation tasks.);
- using the query quantitative information in standard scientific units to identify the stored description including the descriptive quantitative information in standard scientific units (the use of standard scientific units appropriate to the technology would have been obvious to the ordinary practitioner of the art.);
- translating the descriptive quantitative information in standard scientific units into the query user defined units (Col. 6, ll. 32-45. A variety of translation software are available for different translation tasks.); and
- outputting the description including the descriptive quantitative information in the query user defined units (Col. 3, ll. 53-55; Col. 7, ll. 34-40).

Donner does not explicitly disclose at least one server computer connected to one or more client computers via a network. However, Eder discloses at least one server computer connected to one or more client computers via a network (Col. 5, ll. 16-30) It would have been obvious for an ordinary practitioner of the art at the time of applicant's invention to have applied the disclosures of Donner with the disclosures of Eder to construct a storage and retrieval system for intellectual property assets motivated by a desire to provide computer automated evaluations of the commercial worth of intellectual property (Donner, Col. 2, ll. 45-61) and to provide financial evaluations of the impact of intellectual property on a business (Eder, Col. 4, ll. 59-67).

Conclusion

7. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Siegfried Chencinski whose telephone number is 703-305-6199. The Examiner can normally be reached Monday through Friday, 9am to 6pm. If attempts to reach the Examiner by telephone are unsucccessful, the Examiner's supervisor, Hyung S. Sough, can be reached on 703- 308-0505.
Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 308-1113.
Any response to this action should be mailed to:

Commissioner of Patents and Trademarks Washington D.C. 20231

or faxed to:

(703)872-9306 [Official communications; including After Final communications labeled "Box AF"]

(703) 746-9601 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 5, 2411 Crystal Drive, Arlington, VA, 7th floor receptionist.

SEC
September 15, 2004

HYUNG SOUGH
SUPERVISORY PATENT EXAMINER
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